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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,968	09/05/2003	Peter Hutter	14569	8908
23676	7590	10/05/2004	EXAMINER	
SHELDON & MAK, INC 225 SOUTH LAKE AVENUE 9TH FLOOR PASADENA, CA 91101			PATEL, MITAL B	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/655,968

Applicant(s)

HUTTER ET AL.

Examiner

Mital B. Patel

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/5/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference character 106. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

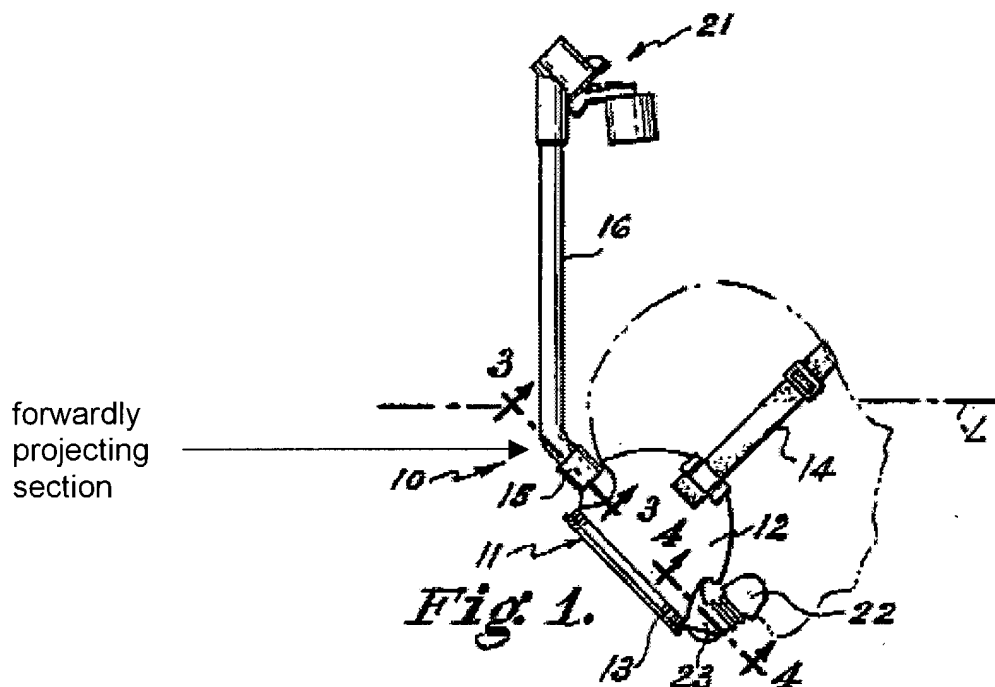
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5, 10, 13, 15, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Girden (US 3,166,083).

Art Unit: 3743

4. **As to claim 1**, Girden teaches a snorkeling apparatus comprising an eye cover **11** device comprising at least one lens (**See Col. 3, lines 63-67**), a frame **13** for holding the lens, and a retainer **14** for retaining the device in watertight relationship on the face surface surrounding the eyes of a user, wherein the frame has a central portion that is located to be centrally positioned on the face of a user; and a snorkel **10** rigidly connected to the central portion of the frame (**See Figs. 1 and 2**).
5. **As to claim 3**, Girden teaches an apparatus wherein the eye cover device is a mask with one lens (**See Figs. 1 and 2**).
6. **As to claim 5**, Girden teaches an apparatus wherein the snorkel comprises a breathing tube **16**, and wherein the breathing tube comprises a forwardly projecting section (**See Fig. 1 attachment below**) that is located below the waterline when the apparatus is used for hydrodynamic drag.



7. As to claim 10, Girden teaches a snorkeling apparatus comprising an eye cover 11 device having at least one lens (See Col. 3, lines 63-67) for being held in watertight relationship over the eyes of a user; a snorkel 10 supported by the eye cover device, the snorkel comprising a mouthpiece 22 and a breathing tube 16 having a lower end and an upper end for extension above a water surface, the lower end being connected to the mouthpiece (See Col. 4, lines 49-59), and a purge tube 23 between the mouthpiece and the eye cover device for purging water from under the lens of the eye cover device.

8. **As to claim 13**, Girden teaches an apparatus wherein the purge tube has a lower end at the mouthpiece and an upper end at the eye cover device (**See Fig. 4**), and wherein the purge tube lower end is closer to a user's mouth than is the lower end of the breathing tube (**See Fig. 1**).

9. **As to claim 15**, Girden teaches an apparatus wherein the purge tube directly connects the mouthpiece to under the lens of the eye cover device.

10. **As to claim 17**, Girden teaches a method of swimming comprising the steps of wearing the snorkeling apparatus of claim 1 with the lens in substantially water tight relation over the eyes and the snorkel centrally positioned between the eyes; and thereafter swimming face down (**See Fig. 1**).

11. **As to claim 18**, Girden teaches a method of swimming comprising the steps of wearing the snorkeling apparatus of claim 10 with the lens in substantially water tight relation over the eyes and the snorkel centrally positioned between the eyes; thereafter swimming face down (**See Fig. 1**); and blowing water out of the space between the lens and the eyes by blowing through the purge tube **23** (**See Col. 4, lines 60-75**).

12. Claims 1, 2, 6, 7, 8, 9, 10, 13, 14, 16, 19, 20, 21, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Riffe (US 6,073,626).

13. **As to claim 1**, Riffe teaches a snorkeling apparatus comprising an eye cover **12** device comprising at least one lens **16**, a frame **18** for holding the lens, and a retainer **20,32** for retaining the device in watertight relationship on the face surface surrounding the eyes of a user, wherein the frame has a central portion (**the Examiner considers element 20 of the mask to be located centrally on the side of the mask**) that is

located to be centrally positioned on the face of a user; and a snorkel (**See Fig. 1**) rigidly connected to the central portion of the frame (**See Figs. 1 and 2**).

14. **As to claim 2**, Riffe teaches a snorkeling apparatus comprising an eye cover **12** device comprising at least one lens **16**, a frame **18** for holding the lens, and retainer **20,32** for retaining the device in watertight relationship on the face surface surrounding the eyes of a user, the retainer comprising a strap **22** adapted to loop over the top of a user's head and engage the distal portion (**engages distal portion at 26**) of the snorkel to hold it in place; and a snorkel (**See Fig. 1**) connected (**via 20**) to the frame, a distal portion of the snorkel being configured to extend over the top of user's head, and wherein the strap is adapted to engage the distal portion of the snorkel to hold it in place (**See Fig. 1**).

15. **As to claim 6**, Riffe teaches an apparatus wherein the snorkel comprises (i) a breathing tube **126**, (ii) a mouthpiece support **42**, (iii) a mouthpiece **46** supported by the mouthpiece support, and (iv) a connector **60,120,124,200** movably connecting the breathing tube and the mouthpiece support, wherein the connector allows relative vertical movement between the mouthpiece and the breathing tube.

16. **As to claim 7**, Riffe teaches an apparatus wherein the connector **60,200** allows relative rotational movement between the mouthpiece and the breathing tube.

17. **As to claim 8**, Riffe teaches an apparatus wherein the snorkel comprises (i) a breathing tube **126**, (ii) a mouthpiece **46**, (iii) a connector **60,120,124,200**, and (iv) an extension distal **44** from the mouthpiece movably connected to the breathing tube so that the extension can move farther from or closer to the mouthpiece.

18. **As to claim 9**, Riffe teaches an apparatus wherein the snorkel comprises a distal portion (**See Fig. 1**) that extends over the top of a user's head, and the retainer comprises a strap **22** adapted to loop over the top of a user's head and engages the distal portion of the snorkel to hold it in place.

19. **As to claim 10**, Riffe teaches a snorkeling apparatus comprising an eye cover **12** device having at least one lens **16** for being held in watertight relationship over the eyes of a user; a snorkel (**See Fig.1**) supported by the eye cover device, the snorkel comprising a mouthpiece **46** and a breathing tube **126** having a lower end and an upper end for extension above a water surface, the lower end being connected to the mouthpiece (**See Fig.1**), and a purge tube **50** between the mouthpiece and the eye cover device for purging water from under the lens of the eye cover device.

20. **As to claim 13**, Riffe teaches an apparatus wherein the purge tube has a lower end at the mouthpiece and an upper end at the eye cover device (**See Fig. 1**), and wherein the purge tube lower end is closer to a user's mouth than is the lower end of the breathing tube (**See Fig. 1**).

21. **As to claim 14**, Riffe teaches an apparatus wherein the purge tube and breathing tube are situated with respect to the mouthpiece so that the breathing tube can be blocked by a user's tongue without blocking the purge tube.

22. **As to claim 16**, Riffe teaches snorkeling apparatus comprising: a) an eye cover **12** device comprising (i) at least one lens **16**, (ii) a frame **18** for holding the lens, and (iii) a retainer **20,32** for retaining the device in watertight relationship on b) the face surface surrounding the eyes of a user, the retainer comprising a strap **22** adapted to loop over



Art Unit: 3743

the top of a user's head, wherein the frame has a central portion (**the Examiner considers element 20 of the mask to be located centrally on the side of the mask**) that is located to be centrally positioned on the face of a user; and a snorkel rigidly connected to the central portion of the frame, the snorkel comprising (i) a mouthpiece **46** and (ii) a breathing tube **126** having a lower portion and an upper portion for extension above a water surface, the lower portion (**at 120, 124**) being connected to the mouthpiece, the upper portion (**at 28, 32**) of the snorkel being configured to extend over the top of a user's head, and wherein the strap **22** is adapted to engage the upper portion of the snorkel to hold it in place.

23. **As to claim 19**, Riffe teaches an apparatus comprising: a) an eye cover device **12** comprising (i) a lens structure **16**, (ii) a frame **18** for holding the lens structure, and (iii) a retainer **20,32** for retaining the device in watertight relationship on the face surface surrounding the eyes of a user, wherein the frame has a central portion (**the Examiner considers element 20 of the mask to be located centrally on the side of the mask**) that is located to be centrally positioned on the face of a user; and a snorkel comprising (i) a lower mouthpiece portion **42**, (ii) an upper portion (**at 28,32**) rigidly connected to the central portion of the frame, and (iii) a connector **60,120,124,200** movably connecting the mouthpiece portion to the upper portion so that the mouthpiece portion can be moved away from a user's mouth to allow use of a regulator.

24. **As to claim 21**, Riffe teaches an apparatus wherein the snorkel comprises a breathing tube **126**, and wherein the breathing tube comprises a forwardly projecting

Art Unit: 3743

section **44** that is located below the waterline when the apparatus is used for hydrodynamic drag.

25. **As to claim 22**, Riffe teaches an apparatus wherein the purge tube and breathing tube are situated with respect to the mouthpiece so that the breathing tube can be blocked by a user's tongue without blocking the purge tube

26. **As to claim 23**, Riffe teaches a method of swimming comprising the steps of wearing the snorkeling apparatus of claim 2 with the lens in substantially water tight relation over the eyes and the snorkel centrally positioned between the eyes; and thereafter swimming face down.

### ***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 3743

29. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

30. Claims 4, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girden (US 3,166,083).

31. **As to claim 4**, Girden teaches essentially all of the limitations except for wherein the eye cover device is goggles with two lenses. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the eye cover device of Girden to be goggles with two lenses because Applicant has not disclosed that goggles with two lenses provides an advantage, is used for a particular purpose, or solves a stated problem, or provides unexpected results. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the mask with one lens of Girden because the eye cover device of Girden would perform equally well since the function of the eye cover device to provide a seal over the eyes is not altered by the number of lenses provided on the eye cover device. Therefore, it would have been an obvious matter of design choice

Art Unit: 3743

to modify Girden to obtain the invention as specified in claim 4. Furthermore, it should be noted that the use of goggles with two lenses is well known in the swimming art.

32. **As to claim 11**, Girden teaches essentially all of the limitations except for wherein the purge tube is of smaller diameter than the breathing tube. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the purge tube of Girden to be within the breathing tube because Applicant has not disclosed that a purge tube of a smaller diameter provides an advantage, is used for a particular purpose, or solves a stated problem, or provides unexpected results. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the purge tube of Girden because the function of the purge tube is not altered by the diameter size and would perform equally well. Therefore, it would have been an obvious matter of design choice to modify Girden to obtain the invention as specified in claim 11.

33. **As to claim 12**, Girden teaches essentially all of the limitations except for wherein the purge tube is within the breathing tube. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the purge tube of Girden to be within the breathing tube because Applicant has not disclosed that a purge tube within the breathing tube provides an advantage, is used for a particular purpose, or solves a stated problem, or provides unexpected results. One of ordinary skill in the art,

furthermore, would have expected Applicant's invention to perform equally well with the purge tube of Girden because the function of the purge tube of Girden is not altered by its location and would perform equally well. Therefore, it would have been an obvious matter of design choice to modify Girden to obtain the invention as specified in claim 12.

34. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riffe (US 6,073,626) in view of Winefordner et al (US 6,079,410).

35. **As to claim 20**, Riffe teaches essentially all of the limitations except for the step of breathing through a regulator. However, Winefordner teaches a snorkel device having a mouthpiece portion which is able to be moved away from the mouth so that a regulator may be used to provide oxygen when the diver is not using a snorkel. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to breath through the regulator after moving the mouthpiece portion of the snorkel away from the mouth as taught by Winefordner so that the user may use oxygen supplied via the regulator when not using the snorkel.

36. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Girden (US 3,166,803) in view of Chen (US 5,553,606).

37. **As to claim 24**, Girden teaches essentially all of the limitations except for the apparatus comprising a light source. Chen in a snorkeling device teaches a light source on a face mask to provide lighting to a diver. Therefore, it would have been obvious to one of ordinary skill in the art to provide a light source as

Art Unit: 3743

taught by Chen to the apparatus of Girden so that lighting may be provided to the diver.

### ***Conclusion***

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6668823, US 6666210, US 6626178, US 6598239, US 6478024, US 6435178, US 6155253, US 5979441, US 5906199, US 5860168, US 5642429, US 5608920, US 5575277, US 5572989, US 5558466, US 5485832, US 5479917, US 5329643, US 6199421, US 4910806, US 4907582, US 4897064, US 4562836, US 4527658, US 4304229, US 3345984, US 2909959, US 2888010, US 2815751, US 2317237, US 2317236, US 1324747, US 2001/0013346, and FR 2720050.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mital B. Patel whose telephone number is 703-306-5444. The examiner can normally be reached on Monday-Friday (8:00 - 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mital B. Patel  
Examiner  
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